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| WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606 | | | EXAMINER MOONEYHAM, JANICE A | |
| | | | ART UNIT 3629 | PAPER NUMBER |

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,206

Applicant(s)

HALLIGAN ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 and 119-123 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-70 and 119-123 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on January 9, 2006, wherein, claims 1-70 and 119-123 are currently pending. No claims have been amended. Applicant is requesting reconsideration of the October 7, 2005 Office Action.

Claim Rejections - 35 USC § 112

2. The Examiner is maintaining the rejection in light of the applicant's remarks in the request for reconsideration. The Examiner has requested that the applicant indicate the structure used in the means plus function language. Applicant has directed the Examiner to Figure 1, wherein the applicant states that the user interface is for providing criteria and the means for receiving a numerical score. In claim 8, applicant claims a means for characterizing whether the trade secret constitutes negative know-how. A user interface alone cannot characterize whether a trade secret is negative know how. An interface is for displaying information. The applicant states on page 34 of the remarks, that the means for associating said security measures with a trade secret is an interactive box on the user interface. The interactive box is the means for entering the information. The means for specifying the values for the six factors of a trade secret appears that a person. The values are entered via a computer but the specification of the values appears to be done in the human mind.

3. Claims 1-70 are 119-123 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant's specification does not disclose adequate structure for performing the recited function. For example, in claim 1 the applicant claims a means within the programmed computer for providing a predetermined criteria for evaluating a potential trade secret. In claims 8-12, 14, 16-20, 23-31, 49-51, 53-56, 60, 62-63, 67 and 69, applicant claims a means for characterizing (whether the trade secret constitutes negative know-how, whether the trade secret is a combinational trade secret), means for specifying security measures, means for associating said security measures with a trade secret, means for specifying, means for determining which security measures are needed, means for specifying security threats, means for analyzing the ratio, means for specifying values for the six factors of a trade secret, means for determining employee exposure to a trade secret, means for characterizing employee exposure, means for characterizing security risk. What is the means for providing the predetermined criteria for evaluating?

Applicant is respectfully requested to specifically point out the means in the claim limitation and the functionality of these means in performing the steps or functions. (See MPEP Section 2181)

How is the calculation performed? The applicant has provided no formulas with which the applicant performs the calculation. The applicant has not defined how the security measure factor is determined. The applicant talks about a threshold value in the specification and never really defines how the threshold value is determined. How

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are the values weighted? How is the net present value of a trade secret calculated?

How is the economic benefit factor calculated? What and how are the characterizations as to whether the trade secret constitutes negative know-how made? In claim 22, the applicant claims a means for calculating various weighted values of the six factors using logical and mathematical equations. The applicant has failed to provide the mathematical equations used to perform calculations. How are the security threats factors calculated?

4. Furthermore, the applicant has identified an invention which requires the user to input information into a computer through the use of a questionnaire with multiple-choice questions wherein many of the questions have answers that are provided by the subjective analysis of the user. Because the answers are subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. This subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the result would be different and would have a different meaning. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to use the invention – to the point that the users become the inventor of their own application of the invention rather than the applicant.

Thus, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention since

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the subjective interpretation does not provide a concrete result which can be used by one in the industry other than the person actually entering the information.

5. Furthermore, claims 1-70 and 119-121 are also rejected under 35 U.S.C. 112, first paragraph since the claimed invention is not supported by either a specific asserted utility or a well established utility. For the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. The applicant has not defined the numerical score. There is no defined meaning as to the score. It is unclear how one skilled in the art would know how the numerical score derived by the invention would be used or what the meaning of the score is to anyone other than what it means in the mind of the person actually entering the information. It is unclear how the numerical score value would be used by a person in the industry, i.e., what would the score mean to a person in the industry, especially in view of the fact that any comparison is made by comparing the assigned values with a predetermined threshold value which is not an industry standard value or a mathematically derived standard but rather a value chosen by the user (page 15 of the remarks section to the response).

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 120 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant states in the preamble that the invention is a programmed computer, said method implemented by the computer. It is not clear whether the applicant is claiming an apparatus or a method.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-70 and 119-123 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect

In the present case, many of the answers to the multiple-choice questions in the questionnaire are subjective. Thus, because the answers are subjective, for a single situation, there could be different results based on the subjective determination of the user. Therefore, the applicant's invention is not capable of providing concrete results as

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required by 35 U.S.C. 101 since it would be difficult for a person to repeat the analysis and determination of another based on the subjective subject matter without undue experimentation.

Furthermore, the claimed invention is not supported by either a credible asserted utility or a well established utility. It is unclear how the specific utility of the claimed invention as described in the disclosure of this application would be useful or tangible to one in the industry. It is unclear how the numerical score value would be used by a person in the industry, i.e., what does the score mean to a person in the industry, especially in view of the fact that any comparison is made by comparing the assigned values with a predetermined threshold value which is not an industry standard value or a mathematically derived standard but rather a value chosen by the user (page 15 of the remarks section to the response). For example, an academic test score of 95 is considered an A unless specifically defined otherwise. What does the numerical score value that is derived by this invention mean and to whom does it have a meaning. Is there a threshold value that has a real world meaning?

8. Claims 8-31, 49-56 and 69 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2105 states if the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.

The means for performing the function in the above referenced claims appears to be a person. Therefore, these claims are directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 3-35, 37-39, 43-44, 47-57, 60-63, 67-70 and 121 are rejected under 35 U.S.C. 102(e) as being anticipated by Donner (US 6, 263, 314).

Referring to Claims 1, 3-35, 37-39 43-44, 47-57, 60-63, 67-70, and 121:

Donner discloses a system for providing documentation, analysis, auditing, and accounting of IP (which includes trade secrets), said system comprising:

a data processing means for calculating (Fig. 1 (6), Fig. 8 (250); col. 11, lines 1-10);

a user interface means for providing predetermine criteria for a user to evaluate a potential trade secret and to receive a numerical score (Figure 1 (2); Fig. 7, Fig. 8 (264));

a mass data storage means (Fig. 1 (4)(5), Fig. 2);

a means for indexing (Fig. 3 (indicator collection organizing device));

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a means for storing or archiving or indexing (Fig. 1 (4) (5), Fig. 2);

a means for associating (Fig. 1 (10), Fig. 3 comparison device);

a means for analyzing, comparing and weighing (col. 5, lines 5-17; Figure 1 (8)

Figure 2 (20));

a means for ranking (col. 9, lines 61-64)

The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim as long as the prior art system is fully capable of performing that function (See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

10. Claims 1-41, 43-44, 47-57, 60-63, 67-70 and 121 are rejected under 35 U.S.C. 102(e) as being anticipated by Elder (US 6,393, 406).

Elder discloses a system comprising:

data processing means (Fig. 3 (136);

user interface for providing predetermined criteria and receiving data (Fig. 1 (20));

mass data storage means (Fig. 1 (15, 10, 30, 35, 40, 50) Fig. 3 (135)

printer means (Fig. 3 (137), Fig. 12 (118))

calculating means (Fig. 1 (400), Fig. 12 (772))

comparison or analysis means (Fig. 12 (773)

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The language directed to an intended use of the system in a claim for an apparatus or system does not result in a structural or functional difference with respect to the prior art and held not to serve as a limitation on the claim as long as the prior art is fully capable of performing the function. (See *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 42, 45-46, 58-59 and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donner and Elder as applied to claim 1 above, and further in view of Haber et al (US 5,136,646) (hereinafter referred to as Haber).

Neither Donner or Eder disclose an application fingerprint of the data. However, Haber discloses creating an application fingerprint of the data (col. 3, lines 50-55).

It would have been obvious to one of ordinary skill in the art to combine the fingerprint as taught by Haber with the scoring and ranking disclosed in Donner and Eder so that once the scored and ranked information is stored, there is a way to verify the date so that, should the time become a matter for later proof, the established procedure serve as effective evidence in substantiating the

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fact.

12. Claims 2 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donner as applied to claim 1 above, and further in view of Eder.

Donner does not disclose a printer. However, Eder discloses a printer (Figure 7 (137)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the auditing system of Donner the printer of Eder so that the reports generated could be produced for in hardcopy for review and storage.

13. Claims 119-120 and 122-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer (US 6,356,909) (hereinafter referred to as Spencer) in view of Barney et al (6,556,992) (hereinafter referred to as Barney).

Spencer discloses computer method, system and program, comprising:

providing a questionnaire of multiple-choice questions (Figures 14, col. 12, line 65 thru col. 13, line 18 - *multiple choice questions*) ;

providing a numerical score value to each of the responses on the questionnaire (col. 12, line 65 thru col. 13, line 18 *multiple choice questions may have a sliding value depending on the answer selected. Each question/selection is given a weight that is used to develop a scorecard*);

accepting responses to the questionnaire through the input device (col. 13, lines 11-18 *individual question responses, Figure 3A – (4) Response database*);

converting the responses received to a numerical score value (col. 12, line 65 thru col. 13, line 18 *scorecard*).

Spencer does not disclose that the subject matter of the invention is trade secrets or that the questions relate to the six factors for a trade secret of the First Restatement of Torts, or calculating a geometric mean, the sixth root of the product, of the numerical score values to create a single metric, or repeating the program for each of the remaining items to be evaluated or ranking the items in ascending or descending order of the calculated metric.

However, Barney discloses repeating the program for each of the remaining items to be evaluated and ranking the items, wherein the items are patents and other intangible intellectual property assets (*trade secrets*) (col. 5, lines 56-62, col. 6, lines 3-9 *ratings or rankings are generated using a database of information by identifying and comparing various characteristics of each patent to a statistically determined distribution of the same characteristic within a given patent population*, col. 7, lines 51-60 – *ranking in ascending or descending order is inherent in the definition of ranking as admitted by applicant on page 18 or the Remarks*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ranking of intellectual property assets as taught by Barney into the disclosure of Spencer so as to allow an entity to identify and study relevant characteristics of intellectual property to determine and measure those metrics that are predictive of a possible future event, such as an intangible intellectual property asset being litigated.

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Although Barney discloses a rating for patents and other intangible intellectual property assets, neither Spencer or Barney explicitly disclose rating trade secrets or the questions relating to the six factors for a trade secret of the First Restatement of Torts or calculating a geometric mean, the sixth root of the product, of the numerical score value.

However, a geometric mean is old and well known. Geometric mean as defined by the Merriam Webster on line dictionary as:

Main Entry: **geometric mean**

Function: *noun*

: the n th root of the product of n numbers; *specifically* : a number that is the second term of three consecutive terms of a geometric progression <the *geometric mean* of 9 and 4 is 6>

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Spencer to include a geometric mean that is the sixth root of the product since the applicant has identified six factors for a trade secret, thus the 6th root of the product of 6 numbers to come up with a numerical score value which can be used for comparison purposes when making an analysis of the trade secret.

The fact that the subject matter is about trade secrets or that the questions relate to the First Restatement of Torts is determined to be non-functional descriptive data. The language is not functionally interrelated with the useful acts, structure or properties of the claimed invention. The weighted scoring and ranking would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d

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1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), *In re Lowry*, 32 F. 3d. 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide weighted scoring and ranking of trade secrets because such data does not functionally relate to the steps of the method or the structure of the system and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

14. Applicant's arguments filed January 9, 2006 have been fully considered but they are not persuasive.

The Examiner has renewed the rejection under 35 USC 112, first paragraph. The specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

As for the rejection as to the claims being rejected by Donner and Eder, the rejections have been maintained. The applicant has claimed a system. Therefore, the Examiner looks at the structure defined in the claim language and whether the prior art has the capability of performing the steps that the applicant claims that applicant's structure can perform. While features of an apparatus or system may be recited either structurally or functionally, claims directed to an apparatus or system must be distinguished from the prior art in terms of structure rather than function alone. If the Examiner has reason to believe that a functional limitation can be performed by the prior art structure, the examiner should establish a prima facie case, and then the burden shifts to the applicant to prove otherwise. Applicant has failed to meet this burden. It is the Examiner's position that both Donner and Eder disclose all the claimed structural limitations and that the disclosed structure is capable of performing the recited function.

Since applicant is claiming a system in this application, applicant must identify in the specification the corresponding structure or the equivalents for the "means for." It is

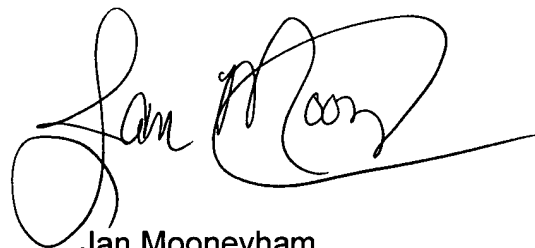
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the Examiner's position that the applicant has failed to make clear the corresponding structure or acts disclosed in the specification for the means plus function language.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a long horizontal flourish extending to the right.

Jan Mooneyham
Patent Examiner
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